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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,915	02/05/2004	Tim Nieman	297912003410	5246

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EXAMINER

WOLLSCHLAGER, JEFFREY MICHAEL

ART UNIT PAPER NUMBER

1732

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/772,915

Applicant(s)

NIEMAN ET AL.

Examiner

Jeff Wollschlager

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed September 20, 2006 have been fully considered but they are not persuasive.

Applicant's arguments appear to be on the following grounds:

1. The tube, as taught by Colone et al., contracts during the process of heating the calendered tube and as such the requirement of claims 1 and 9 that the final inner diameter is maintained "substantially constant" is not met. Further, the examiner's statement in the final rejection that "...this is no different than what takes place in practicing the pending claims (U.S. Patent Application Publication 2004/0164445, paragraph [0021])" is not accurate.
2. There is no objective reason why utilizing a second plate would have been obvious in view of Colone et al.
3. Absent the benefit of Applicant's own disclosure there is no suggestion or motivation to combine either Herweck et al. or Egres, Jr. with Colone et al.

The arguments are not persuasive for the following reasons:

1. The tube, as taught by Colone et al., is disposed on a mandrel for the step of heating the tube above its crystalline melt-point (see Figure 7C; col. 5, lines 61-67). Colone et al. do state, "heating causes the tubes to soften, radially contract, and to lightly adhere to each other, and to mandrel 40" (col. 5, lines 63-64). However, this is no different than what takes place in practicing the pending claims (U.S. Patent

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Application Publication 2004/0164445, paragraph [0021]). Specifically, the instant case and Colone et al. heat the same claimed material in the same claimed way while disposed on a mandrel. When the tube taught by Colone et al. grips the mandrel it does result in a slight change in the diameter of the tube, by definition. However, there is no evidence on the record showing that the instant tube while being heated on the mandrel also does not grip the mandrel when it is heated. It is the examiner's position that, as claimed, the instant tube does grip the mandrel as the Colone et al. reference discloses. Further, the claims require the diameter to be maintained "substantially constant" and do not require the diameter remain constant. Since the same claimed material is being heated in the same claimed way while disposed on a mandrel, the diameter in Colone et al. is understood to be maintained "substantially constant". The mandrel employed by Colone et al. maintains the diameter "substantially constant".

2. The examiner points to the teaching in Colone et al. showing the hand calendering process may be automated by loading the mandrel into a machine which accomplishes the same effect by generating a press nip (col. 5, lines 18-22). It is the examiner's position that employing a second plate, in addition to the disclosed first plate, on top of the tube to provide this press nip would have been *prima facie* obvious. Particularly, the hand calendering process employed by Colone et al employs a single plate while rolling the tube several times and pressing down on the mandrel. When automating this process a mechanism and means for providing this pressing down/press nip would be required. Providing a second flat plate, as a substantial

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duplicate of the first plate, as the means would have been an obvious choice at the time of the claimed invention in view of the teaching and suggestion of Colone et al.

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

JW

Jeff Wollschlager
Examiner
Art Unit 1732

September 29, 2006


CHRISTINA JOHNSON
PRIMARY EXAMINER

10/2/06